

**REMARKS:**

Reconsideration and allowance in view of the foregoing amendments and the following remarks are requested. By this amendment, Applicants have amended claims 196, 200, 262-272. Claim 261 has been cancelled. New claims 273-275 have been added to define further embodiments of the invention. No new matter is added.

**Rejections under 35 U.S.C. §112 and §101**

Claims 261-272 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite and under 35 U.S.C. §101. Applicants submit that claim 261 has been cancelled and the "method of use" claims (262-272) have been amended to recite the active, positive steps of the method as required under 35 U.S.C. §101 and §112. Support for claim 262 can be found on pages 314-315 of the specification. Support for claim 268 can be found on page 298, second paragraph of the specification. Applicants submit that the pending claims are now definite under §112 and recite proper steps under §101. Further, clauses including the term "preferably" in claims 270-272 were deleted and new claim 273 was added to recite this subject matter that was deleted from claim 272.

Claims 196 and 200 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner asserts that the language "preferably" renders the claims indefinite. Applicants submit that the clauses starting with the term "preferably" have been deleted from claims 196 and 200. The subject matter deleted from these claims is presently recited in new claims 274 and 275, depending from claims 196 and 200, respectively.

Thus, Applicants submit that the rejections under 35 U.S.C. §101 and §112 have been obviated as result of the foregoing amendments. Applicants request that the rejections under 35 U.S.C. §101 and §112 be withdrawn.

### **Claim Objections**

Claims 261-272 were objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants submit that claim 261 has been canceled thus obviating the objection. Claims 262-267, as amended, are directed to a method of treatment of a disease and claims 268-272, as amended, are directed to a method of inhibiting a rotamase. Thus, Applicants submit that the present claims further limit the subject matter of the previous claim. Applicants request that the objections be withdrawn.

### **Rejections under 35 U.S.C. §103**

Claims 184, 188-189, 191, 193-196, 200-202, 206-207, 209-213, 215, and 257-258 were rejected under 35 U.S.C. §103(a) as being obvious over Olesen et al. (U.S. 5,696,138) or Salituro et al. (U.S. 6,093,742). The Examiner states that the compounds disclosed in columns 2-4 of Olesen and column 2 of Salituro are structurally similar to the presently claimed compounds and compositions and asserts that it would have been obvious to obtain compounds within the generic disclosure of the references with a reasonable expectation of achieving a successful composition.

Applicants submit that the presently claimed compounds, which are not specifically disclosed in the prior art, have surprising and unexpected and improved

properties over the prior art. Tables 2-4 provide the  $IC_{50}$  values for rotamase inhibition by the tested compounds. Applicants are in the process of gathering the necessary documentation of experimental results showing the improved and unexpected results obtained from the presently claimed compounds compared with the cited art compounds.

Presently, Applicants submit that in addition to not being specifically disclosed in either reference, the elected species, compound 264, is not defined by the general structure disclosed in Olesen (because  $R^2$  cannot be methyl). Olesen relates to treating convulsive disorders by activating potassium channels (see col. 16, lines 33-50). Salituro proposes treating a wide variety of diseases by inhibiting the mammalian protein kinase p38 (col. 1, lines 34-52). Neither reference relates to the use of the presently claimed compounds to inhibit rotamase activity. Thus, Applicants submit that the presently claimed compounds and methods would not have been obvious to one of ordinary skill in the art because they are specifically selected for their unexpected properties as rotamase inhibitors, an area of the art not anticipated by or obvious in view of either cited reference. Applicants request that the outstanding rejections under 35 U.S.C. §103(a) be withdrawn.

In view of the foregoing, reconsideration and allowance of the pending claims are requested.

The Director is authorized to charge any fees or overpayment to Deposit Account No. 02-2135.

Respectfully submitted,

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